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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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7590

07/03/2002

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EXAMINER

YU, MISOOK

ART UNIT

PAPER NUMBER

1642

DATE MAILED: 07/03/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n N .

09/825,751

Applicant(s)

VERNET ET AL.

Examiner

Misook Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-49 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

***Each polypeptide and each DNA molecule with its own SEQ ID NO is patentably distinct product.***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Groups 1-10. Claims 1-4, 38, and 41, drawn to polypeptide and variants, classified in class 530, subclass 350. ***Each SEQ ID number is a different invention.***

Groups 11-20. Claims 5-14, 39, and 42, drawn to DNA and variants, vector, cell, classified in class 536, subclass 23.5. ***Each SEQ ID number is a different invention.***

Groups 21-30. Claims 15-17, 40, and 43, drawn to antibody, classified in class 530, subclass 387.1. ***Antibody that binds to each SEQ ID number is a different invention.***

Groups 31-40. Claims 18, 44, and 45, drawn to method to determine presence of invention groups 1-10, classified in class 435, subclass 7.1.

Groups 41-50. Claims 19-21, 46, and 47, drawn to method to determine presence of invention groups 11-20, classified in class 435, subclass 6.

Groups 51-60. Claims 22, 23, drawn to method of identifying agents that bind to inventions 1-10, classified in class 435, subclass 4.

Groups 61-70. Claim 24, drawn to method of identifying agent that modulate expression of inventions 1-10, classified in class 436, subclass 504.

Groups 71-80. Claims 24 and 25, drawn to method of identifying agents that modulate activity of inventions 1-10, classified in class 436, subclass 501.

Groups 81-90. Claims 26-29, and 48, drawn to method of treatment or prevention using inventions 1-10, classified in class 514, subclass 2.

Groups 91-100. Claims 30-33, drawn to method of treatment or prevention using invention of 11-20, classified in class 514, subclass 44.

Groups 101-110. Claims 34-37, and 49, drawn to method or treatment of prevention, classified in class 424, subclass 130.1.

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The inventions are distinct, each from the other because of the following reasons:

Inventions 1-10 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different human proteins with different molecular structures and different biological properties.

Inventions 11-20 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different genes that encode different human proteins with different molecular structures and different biological properties.

Inventions 21-30 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are different antibodies that bind to different human proteins with different molecular structures and different biological properties.

Inventions groups 61-70 and groups 71-80 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions groups 61-70 and groups 71-80 are different method groups because not all agent that modulate expression of inventions 1-10 will modulate activity of inventions 1-10.

Inventions 1-10 (product) and 31-40, 51-60, 61-70, 71-80, 81-90 (process) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different processes of different invention groups of 31-40, 51-60, 61-70, 71-80, or 81-90.

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Inventions 11-20 (product) and 41-50, 91-100 (process) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different processes of different invention groups of 41-50, or 91-100.

Inventions 21-30 (product) and 101-110, 31-40 (process) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different processes of different invention groups of 101-110, or 31-40.

These inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification. The search required for each of the above inventions is not coextensive with regard to the literature and the sequence searches. Further, a reference which would anticipate the invention of any one group would not necessarily anticipate or make obvious the any of the other groups. For these reasons, restriction for examination purposes is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: Claims 26-28, 30-32, and 34-36. If any invention from groups 81-90, 91-100, or 101-110 is elected, applicant is required under 35 U.S.C. 121 to elect a single disclosed species from each of the three genres for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, (1) method of treatment or prevention (listed in claims 26, 30, 34), (2) the different disorders (listed in claims 27, 31, and 34), (3) the different etiologies (listed in claims 28, 32, and 36) are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims

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readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Misook Yu whose telephone number is 703-308-2454. The examiner can normally be reached on 8 A.M. to 4:30 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-872-9307 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Misook Yu, Ph.D.  
June 26, 2002



ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
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